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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,117	04/25/2000	David L. Patton	81003F-P	9422

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PATENT LEGAL STAFF
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EXAMINER

KIM, CHONG R

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 07/23/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/558,117

Applicant(s)

PATTON ET AL.

Examiner

Charles Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-12 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-12 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Response to Amendment and Arguments

1. Applicant's amendment filed on May 13, 2003 has been entered and made of record.
2. In view of applicant's amendment, the objections to claims 12 and 20 have been withdrawn.
3. In view of applicant's amendment, the 112 second paragraph rejections are withdrawn.
4. Applicant's arguments with respect to claim 10 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

5. Claim 17 is objected to because the phrase "said first indicia" in line 5 lacks antecedent basis. It appears that the applicant intended the phrase to read "said indicia". The objection is also applicable to claim 19. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described

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in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More specifically, the limitation “a second indicia which is invisible under normal viewing conditions, said second indicia comprising a unique ID associated with the captured device used to capture said image; a third indicia in said image which is not visible under normal viewing conditions, said third indicia comprising a unique ID associated with the location or printer used to produce said document” in lines 7-13 is not supported in the applicant’s specification. The applicant’s specification provides support in regards to a first indicia (30) that is in the form of a name (page 7, lines 16-18), a second indicia (40) that is in the form of a document identifier such as a passport number (page 8, lines 1-2), and a third indicia (50) that is a unique identification number that can be used to identify the camera (page 8, lines 10-13), or can also be used to identify a printer used to print the document (page 8, lines 15-17). The Examiner notes that if the indicia (50) can be used to identify the camera, then the claimed “second indicia” in line 7 is supported by the applicant’s specification while the claimed “third indicia” in line 10 is not supported. The Examiner also notes that if the indicia (50) can be used to identify a printer, then the claimed “third indicia” in line 10 is supported by the applicant’s specification while the claimed “second indicia” in line 7 is not supported. The applicant’s specification also provides support in regards to the indicia (50) being used to identify the camera and the printer (page 8, lines 26-28). However, the Examiner notes that the applicant’s specification fails to provide support in regards to a separate second and third indicia associated with the capture device and printer respectively, as claimed.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claim 10, the phrase “scanning said image so as to obtain said unique capture ID associated with said printer and/or location and/or said printer ID” renders the claim indefinite. More specifically, it is unclear which “ID” is obtained from the scanning step.

Claims not mentioned specifically are dependent from indefinite antecedent claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Rhoads, U.S. Patent No. 5,841,886 (“Rhoads”), and Zdybel et al., E.P. 0459792 (“Zdybel”).

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Referring to claim 10, Rhoads discloses a method of verifying that the presenter of an authentication document is the same individual associated with the authentication document, comprising the steps of:

a. providing an image on the authentication document, the image including a first indicia which is not visible under normal viewing conditions, the first indicia comprising a unique ID associated with the holder of the authentication document (col. 7, line 65-col. 8, line 5. Note that the “identification code” in line col. 7, line 66 is interpreted as the first indicia).

Rhoads fails to teach a second indicia which is invisible under normal viewing conditions, that comprises a unique ID associated with the capture device used to capture the image, and a third indicia which is not visible under normal viewing conditions, that comprises a unique ID associated with a printer used to produce the document.

Zdybel teaches an image that includes an indicia which is invisible under normal viewing conditions (col. 9, line 57-col. 10, line 34), that comprises a unique ID associated with the capture device used to capture the image [col. 6, lines 10-19. Note that the “data characterizing the input scanner” in lines 13-14 is interpreted to mean the unique ID associated with the capture device, since the characterizing data will be unique to each specific input scanner used to scan (capture) the image]. Zdybel also teaches an indicia which is invisible under normal viewing conditions that comprises a unique ID associated with a printer used to produce a hardcopy print of the image (col. 5, lines 51-58. Note that “the identification of the machine which performed that print” is interpreted to mean a unique ID associated with a printer, since it identifies the specific printer/device that was used to print the document). Zdybel further explains that the indicias are used for the authentication and verification of the document integrity (abstract).

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Rhoads and Zdybel are both concerned with verifying authentication documents. Zdybel provides a relatively straightforward and reliable method for capturing and communicating data defining the equipment and process employed to prepare the document (Zdybel, col. 13, lines 10-25). Therefore, it would have been obvious to combine the teachings of Rhoads and Zdybel, in order to enhance the authentication process by providing additional information (indicia) that could be used to verify the document. The Examiner notes that the combination of Rhoads and Zdybel would provide a document with a first indicia comprising a unique ID associated with the holder as taught by Rhoads, and a second and third indicia comprising unique IDs associated with the capture device and the printer respectively, as taught by Zdybel.

Rhoads further explains that the contents of the document are scanned so as to obtain the unique ID information contained in the image (col. 4, line 55-col. 5, line 25). Note that scanning the document of Rhoads and Zdybel would obtain the unique ID associated with the holder of the document (first indicia), the unique ID associated with the capture device (second indicia), and the unique ID associated with the printer (third indicia). Rhoads also teaches the step of comparing the unique ID with a known database for verifying the image on the document [col. 5, line 33-col. 6, line 23]. Rhoads explains that the image on the document (that includes the indicia), are stored on a known database (col. 3, lines 19-22 and col. 6, lines 11-14), and is compared with the image (that includes the indicia) that is obtained from the scanning step in order to verify the document]. Note that the step of comparing the unique ID information obtained from the document of Rhoads and Zdybel would include comparing the unique ID associated with the holder of the document (first indicia), the unique ID associated with the capture device (second indicia), and the unique ID associated with the printer (third indicia) with

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the unique ID information stored in the database. As noted above, Zdybel is concerned with capturing and verifying data defining the equipment and process employed to produce the document. Therefore, it would have been obvious to combine the teachings of Rhoads and Zdybel, in order to perform the step of comparing the unique ID associated with the capture device and the unique ID associated with the printer with the unique ID information stored in the database, thereby confirming of the capture device and printing device that was used for producing the document. The ordinary artisan would have been motivated to combine the teachings in order to increase the reliability of the verification process.

Referring to claim 11, Rhoads discloses the step of sending information obtained by scanning of the image to a remote database whereby information relating to unique ID can be viewed and confirmed (col. 5, line 34-col. 6, line 23). Rhoads fails to teach that the information includes a unique ID with respect to the capture device and a unique ID associated with the printer. Zdybel teaches these features, as noted above. Therefore, it would have been obvious to combine the teachings of Rhoads and Zdybel, for the reasons stated above.

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Rhoads, U.S. Patent No. 5,841,886 ("Rhoads"), and Zdybel et al., E.P. 0459792 ("Zdybel"), further in view of Cadorette, Jr. et al., U.S. Patent No. 6,341,169 ("Cadorette").

Referring to claim 12, the combination of Rhoads and Zdybel fail to disclose that the holder of the authentication document is viewed by a camera at presentation so as to obtain an image of the presenter.

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Cadorette discloses a method for verifying a presenter of an authentication (credential) document wherein the holder is viewed by a camera at presentation so as to obtain an image of the presenter, the image being forwarded to a location for comparison with a database to confirm that the individual is associated with that authentication document (col. 11, lines 52-65 and col. 13, lines 6-18).

Rhoads, Zdybel, and Cadorette are all concerned with verifying authentication documents. Cadorette's method provides convenience to an evaluating party by automatically comparing the image on the document with an image of the presenter at the time of evaluation in order to establish a reliable measure of verification (Cadorette, col. 2, line 60-col. 3, line 2). Therefore, it would have been obvious to include the image of the presenter, as taught by Cadorette, in the method of Carr and Zdybel, in order to further enhance the authentication process by increasing the reliability of verification.

10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads, U.S. Patent No. 5,841,886 ("Rhoads").

Referring to claim 17, Rhoads discloses a method for verification comprising:

a. an authentication document (950) having an image of the individual to which the authentication was issued (col. 2, line 64-col. 3, line 8) and an indicia which is not visible under normal viewing conditions, the indicia comprising a unique ID associated with an image of the recipient to which the authentication document was issued (col. 1, lines 59-67. Note that the "multi-bit data related to the photograph" in lines 61-62, is interpreted as being analogous to the indicia comprising a unique ID associated with the image), the unique ID and the image being

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digitally stored at a data base [col. 3, lines 19-22 and col. 4, lines 34-36. Note that the central network (980) is interpreted to mean the data base for storing the image and the unique (information) ID],

b. presenting the authentication document at a remote location by a presenter and scanning the image at the remote location so as to obtain the unique ID [col. 4, line 55-col. 5, line 3. Note that scanning the document (950) at the remote (point-of-sale) location inherently includes the step of presenting the document by a presenter because the document must be obtained from the presenter before it is scanned], and

c. forwarding the unique ID electronically to the data base (col. 5, lines 18-28).

Rhoads does not explicitly state that the image stored in the data base is forwarded to the remote location in response to the received ID for providing visual verification that the presenter is the same as the individual to which the authentication document was issued. However, Rhoads teaches that the images stored in the data base (central network) are “made available” to all the remote locations in the network (col. 4, lines 38-40). Therefore, since the images are “made available” to the remote locations, it would have been obvious to forward the images from the data base to the remote locations in response to the received ID, in order to provide the remote locations with additional verification information, thereby increasing the reliability of the authentication process.

Furthermore, Rhoads explains that his method can be used in any photographic based identification system in order to verify that the presenter of the authentication document is the same individual to which the authentication document was issued (col. 6, lines 44-57 and col. 7, line 13-col. 8, line 5). Rhoads also explains that the image comprises an image of the person that

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the document should belong to (col. 2, lines 65-66). Therefore, it would have been obvious to utilize the images obtained from the database to visually verify the presenter, since the image obtained from the database represents the owner of the document. One would have been motivated to do so in order to facilitate the overall verification process. For example, verification can be accomplished by simply matching the image with the presenter of the document.

11. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads, U.S. Patent No. 5,841,886 ("Rhoads") as applied to claim 17, further in view of Zdybel et al., E.P. 0459792 ("Zdybel").

Referring to claim 18, the claim's use of "or" between the three limitations only requires the prior art to meet either one of the three limitations. In this case, Rhoads fails to teach that the unique ID includes information regarding the capture device.

Zdybel teaches an image that includes an indicia that is invisible under normal view conditions (col. 9, line 57-col. 10, line 34), that comprises a unique ID associated with the capture device used to capture the image (col. 6, lines 10-19. Note that the "data characterizing the input scanner" in lines 13-14 is interpreted to mean the unique ID associated with the capture device).

Rhoads and Zdybel are both concerned with verifying authentication documents. Zdybel provides a relatively straightforward and reliable method for capturing and communicating data defining the equipment and process employed to prepare the document (Zdybel, col. 13, lines 10-25). Therefore, it would have been obvious to modify the unique ID of Rhoads so that it

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includes information regarding the capture device, as taught by Zdybel, in order to enhance the authentication process by providing additional information (indicia) that can be used to verify the document.

12. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cadorette, jr. et al., U.S. Patent No. 6,341,169 ("Cadorette"), further in view of Rhoads, U.S. Patent No. 5,841,886 ("Rhoads").

Referring to claim 19, Cadorette discloses a method of verifying that the presenter of an authentication (credential) document is the same individual to which the authentication document was issued;

a. the authentication document having image of the individual to which the authentication document was issued and an indicia comprising a unique ID associated with an image of the recipient to which the authentication document was issued [col. 12, lines 35-44. Note that the "encoded data" in line 43 is interpreted to mean an indicia comprising a unique ID associated with an image of the recipient, since it is used to retrieve the "verification reference record" (col. 13, lines 3-4). Cadorette teaches that the verification reference record contains image data of the individual identified by the document (col. 13, lines 9-16)], the unique ID and the image being digitally stored at a data base (col. 12, lines 55-58)

b. presenting the authentication document at a remote location by a presenter and scanning the image at the remote location to obtain the unique ID (col. 12, lines 8-25. Note that the unique ID is obtained once the document is optically detected, see col. 12, lines 41-43)

c. capturing a live image of the presenter at the time of presentation (col. 11, lines 52-65)

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d. forwarding the unique ID and the live image electronically to the data base, and comparing the stored image associated with the unique ID with the live image for verification that the presenter is the same as the individual to which the authentication document was issued (col. 13, lines 6-17).

Cadorette fails to teach that the indicia is not visible under normal viewing conditions.

Rhoads teaches an image with an indicia that is not visible under normal viewing conditions (col. 1, lines 59-67).

Cadorette and Rhoads are both concerned with verifying authentication documents. Rhoads's method enhances the security associated with the use of photo ID documents (Rhoads, col. 7, lines 4-5). Therefore, it would have been obvious to modify the indicia of Cadorette so that it is not visible under normal viewing conditions, as taught by Rhoads, in order to enhance the verification process by making it more difficult for an attacker to attempt to remove the indicia from the document.

Referring to claim 20, see the discussion of claim 18 above.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Brothers et al. U.S. Patent No. 5,799,083 discloses a verification system that provides an image with an indicia that is associated with the capture device (camera) used to obtain to the image.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kim whose telephone number is 703-306-4038. The examiner can normally be reached on Monday thru Thursday 8:30am to 6:00pm and alternating Fridays 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.



ck

July 17, 2003


Jon Chang
Primary Examiner